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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,810	01/10/2001	Jochen Voss	Mo-6029/LeA 34,199	7359

157 7590 11/20/2002

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PATENT DEPARTMENT
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EXAMINER
RIBAR, TRAVIS B

ART UNIT	PAPER NUMBER
1711	11

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.	Applicant(s)	
09/757,810	VOSS, JOCHEN	
Examiner	**Art Unit**	
Travis B Ribar	1711	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☒ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). 9.

10. ☐ Other: _____

James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700

Continuation of 5. does NOT place the application in condition for allowance because: The applicant argues that Wolf et al. teaches away from using a swelling agent in the primer composition that it claims. As evidence, the applicant points to column 4, lines 64-68 of the reference, which claims that "a swelling adhesion treatment of the plastic is not necessary," and that by avoiding such a treatment, "the formation of stress cracks is avoided." The applicant believes the plastic that Wolf et al. refers to in this passage is the primer, and as such, the addition of a swelling agent to the primer is outside the scope of Wolf et al.
The plastic that Wolf et al. refers to is not the primer, however, it is the substrate onto which the primer is coated (see column 4, lines 58-63), and the swelling adhesion treatment that the passage refers to is a method of preparing a substrate for electroless plating, not the addition of a swelling agent to the primer. Reichert et al. adequately defines swelling adhesion treatment of a substrate (column 1) and states that the method does indeed lead to stress cracking. Therefore, Wolf et al. does not teach against using a swelling agent in the primer composition, rather it states that a pretreatment of the substrate is not necessary when using the disclosed primer composition. The addition of a swelling agent to the composition is therefore not outside the scope of Wolf et al.

In response to applicant's argument that Volz is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Volz is concerned with the penetration of large molecules into a polymer matrix, which is a problem with which the applicant was concerned. In addition, the examiner notes that Volz was not used to modify Wolf et al. It was only used to provide evidence that the swelling of a polymer composition is known to those in the polymer art to improve the penetration of large molecules into a polymer matrix and thereby provide additional motivation for the use of a swelling agent in Wolf et al. The invention is met by the combination of Lane et al. and Wolf et al., using Volz in an evidentiary role to show what is known in the art.

In response to applicant's argument that Lane et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Lane et al. is in the field of the applicant's endeavor, namely electroless metallization of a substrate.

The applicant's argument for unexpected results is noted, but since there is not sufficient evidence in the record to support such a claim, the argument is not persuasive..